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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/659,581
Filing Date: September 09, 2003
Appellant(s): WADLEIGH, WILLIAM R.

Mr. Rodney L. Lacy
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 8/2/2010 appealing from the Office action mailed 8/20/2009.

PRELIMINARY REMARKS

After further consideration, this application contains at least one claim that does not meet the patent eligibility requirement for statutory subject matter under 35 USC 101. Accordingly, this examiner's answer contains a new ground of rejection under 35 U.S.C. 101. Appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* dismissal of the appeal as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution**. Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal**. Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the **TWO MONTH** time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 1-8, 10-18, 20-25, 27-33, 35-39, 41-48, and 50-58.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The Appellant's statement of the grounds of rejection to be reviewed upon appeal is substantially correct except for the grounds of rejection listed under the subheadings NEW GROUNDS FOR REJECTION and WITHDRAWN REJECTIONS. The changes are as follows:

NEW GROUNDS FOR REJECTION

Claims 38-43 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

WITHDRAWN REJECTIONS

Claims 1-8, 10-18, 20-25, 27-33, 35-39, 41-48, and 50-58 on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1-28 of U.S. Patent No. 6,517,433 to Loose et al. and Claims 1-93 of U.S. Patent No. 7,510,475 to Loose et al. ARE hereby withdrawn based on Appellant's most recent amendments to the claims.

Claims 1, 3-4, 6-8, 17-18, 24-25, 32-33, 38-39, 44, and 46-48 on the grounds of 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement is hereby withdrawn as Appellant has cited support in the Specification.

((7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(**8) Evidence Relied Upon**

6,517,433	Loose et al. (Loose)	2-2003
6,375,570	Poole	4-2002
2003/0027489	Kay	2-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 101

a. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

b. Claims 38-43 are rejected under 35 USC 101 as being directed to non-statutory subject matter wherein the claim recites a processing program that is not claimed as embodied in a non-transitory computer readable medium. Because Appellant's disclosure is not limited solely to tangible embodiments, the claimed subject matter, given the broadest reasonable interpretation, may be a carrier wave comprising of instructions and is, therefore, non-statutory. The United States Patent and Trademark Office (USPTO) is obliged to give claims their broadest reasonable interpretation consistent with the specification during proceedings before the USPTO. See In re Zletz, 893 F.2d 319 (Fed. Cir. 1989) (during patent examination the pending claims must be interpreted as broadly as their terms reasonably allow). The broadest reasonable interpretation of a claim drawn to a computer readable medium typically covers forms of non-transitory tangible media and transitory propagating signals *per se* in view of the ordinary and customary meaning of computer readable media, particularly when the specification is silent. (See MPEP 2111.01). When the broadest reasonable interpretation of a claim covers a signal *per se*, the claim must be rejected under 35

U.S.C. § 101 as covering non-statutory subject matter (See In re Nuijten, 500 F.3d 1346, 1356-57 (Fed. Cir. 2007) (transitory embodiments are not directed to statutory subject matter) and Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101, Aug. 24, 2009; p. 2).

Claim Rejections - 35 USC §§ 102/103

c. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the Appellant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the Appellant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

d. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

e. The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

f. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Appellant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

g. Claims 1-8, 10-13, 17-18, 20- 25, 27-33, 35-39, 41-48, and 50-58 are rejected under 35 U.S.C. 102(e) as anticipated by U.S. Patent No. 6,517,433 to Loose et al. (Loose) of record or, in the alternative, under 35 U.S.C. § 103(a) as being unpatentable under Loose in view of U.S. Patent Pub. No. 2003/0027489 to Kay (Kay).

In Reference to Claims 1, 4, 7, 13, 17, 24, 32, 38, 44, and 47

Loose discloses a system displaying multiple images on a video display with a triggering event activating a game and bonus game under the control of a processor and memory storing game data (Col. 5 Lines 60-67 and Col. 6 Lines 1-16) and computer-readable "instructions" (Col. 6 Lines 14-15 "microcontroller instructs …" based on "game code" Col. 5 Lines 66-67) in a casino wagering game {reel slot machine} (Fig. 11 and Col. 4 Lines 28-40) so that multiple images are to be displayed by one or more reels (Fig. 9a) on a display device (Fig. 11), and

the method comprising:

in response to the triggering criteria (in response to a random or non-random event the video image may depict an animation in which a video indicator 29 is moved …" Col. 5 Lines 1-8), identify a set of video images (Fig. 9a showing "cherries" video indicator 29 from the set of images in the "game data" Col. 5 Lines 63-67 as well as other embodiments e.g., Figs. 7 of a "start-bonus outcome" for triggering a bonus game where additional superimposed images similar to those of figs. 9a and 9b execute (Col. 4 Lines 40-67 and Col. 5 Lines 1-22);

wherein each of the at least one symbol element in one or more displayed reels of a casino machine remains at least partially visible while the supplemental graphical element is displayed {for each play of the game and before a play iteration is completed} (Figs. 9a and 9b disclosing game images during a play of the game) to display a video event (Fig. 9a event 29) overlaying the elements (Col. 2, 25-33, Col. 4, 58-67, and Col. 5, 52-67) and method comprising:

displaying on a video display a supplemental graphical element over at least one symbol element in one or more displayed reels of a casino gaming machine (Figs. 9a and 9b wherein the video indicator 29 supplements the animation of the spinning reels 12a,b, c),

the supplemental graphical element comprising pre-recorded video information including full motion video of a person, place, or thing (Examiner notes Appellant fails to provide one comprehensive definition of "the supplemental graphical element comprising pre-recorded video information including full motion video of a person, place,

or thing". Actually, it appears that several portions from various parts of Appellant's Specification must be read to support Appellant's claim language. For example:

> Page 9 Appellant provides in the context of "video image", a real image, such as a digital or film based photograph, a frame of a motion picture or a television or video camera image which when displayed give the "appearance of full motion video as opposed to the appearance of a still image". In another embodiment, displaying the set of video images could result in the appearance of a still video image. In other embodiments, the supplemental graphical element is an animated or rendered image"; and
>
> Page 15, Appellant discloses that the database of "video images" can represent "a clip from a film or television program" or "other pre-recorded video information (e.g., a non-publicly displayed video of a person, place, or thing)".

Giving the claim its broadest reasonable interpretation in light of the Specification, Examiner finds that the supplemental graphic element comprising pre-recorded video information is pre-recorded video comprising a film or movie frame or clip, graphical element, or rendered image, of a person, place, or thing. Examiner also finds that full motion video of a person, place, or thing, to be animated, or dynamically displayed, video images which give the appearance of full motion video.

Loose discloses supplemental graphic elements of a "video indicator" 29 (Figs. 9a and 9b) comprising pre-recorded video information ("The system memory is used to store game-related data associated with the chance games played on the slot machine. The game-related data may, for example, include …audio resources, and video

resources." (Col. 5 Lines 63-67) including full motion video of a person, place, or thing" (Figs. 9a and 9b, the video indicators 29 crossing the video screen "may be static or dynamic, and may include such graphics as payout values, a pay table, … special effects, thematic scenery, and instructional information" (Col. 2 Lines 30-34);

the displaying including overlaying in a memory storing video data pixel values of the at least one symbol element with pixel values of the supplemental graphical element (Loose discloses a memory structure of Fig. 11 that can be "several alternative types of memory structure or maybe implemented on a single memory structure Col. 5 Lines 52-66. "The system memory is used to store game-related data associated with the chance games played on the slot machine. The game-related data may, for example, include game code, math tables, a random number generator, audio resources, and video resources." Col. 5 Lines 52-67 and Col. 6 Lines 1-15). Examiner interprets the game-related data and the ability to adjust the appearance of the video image 18 "in terms of transparency, translucency, or opacity depending on the purpose of the video image 18" and in terms of "through the proper selection of colors and their level of brightness" (Col. 5 Lines 23-42 to be Appellant's overlaying of pixel data in memory wherein the location of the underlying video image 18 and the video indicator 29 are adjusted based on the location and the pixels that are displayed to produce the resulting images of Figs. 9a and 9b).

wherein each of the at least one symbol element that is overlaid remains at least partially visible while the supplemental graphical element is displayed (Figs. 9a and 9b wherein the image 18 remains partially visible; See also Col. 5 Lines 23-42).

If Appellant disagrees with Examiner's interpretation of Loose as to the definition of pre-recorded video information including full motion video of a person, place, or thing then Appellant is directed to the teachings of Kay.

Kay discloses in a gaming machine the superposition of animation on the reels of fruit machines (Figs. 4a-4b and [0090]) synchronized to audio ([0015]) wherein the animated sequence comprises splicing together potions of a film or video clip ([0014, 0057]). Kay provides this system and method in order to give the viewer a cost-effective "impression of an animation sequence" ([0002, 0057]) displayed in a "realistic, aesthetically appealing, and optionally humorous manner" ([0015]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the spliced portions of a film or video clip to give the impression of an animated film or video as taught by Kay into the teachings of Loose in order to expand the entertainment value of the gaming experience by offering patrons the opportunity to experience film and video clips presented in a realistic, aesthetically appealing, and humorous manner.

In Reference to Claims 2, 5 and 45

Loose as modified by Kay discloses displaying the at least one symbol element; determining, based on the at least one symbol element, whether a triggering event has occurred; and if a triggering event has occurred, identifying the supplemental graphical element as a set of video images (Col. 4 Lines 58-67 and Col. 5 Lines 1-22).

In Reference to Claims 3, 6, 8, 18, 25, 33, 39, 46, and 48

Loose as modified by Kay discloses dynamically altering a size of the supplemental graphical element (Loose depicts a change in the video indicator 29 wherein as the "bunch of "cherries" 29 in Figs. 9a-9b move the boundaries of the graphical image dynamically alter from showing 4 cherries in Fig. 9a to showing 6 cherries in Fig. 9b reflecting a change in the relative size of the image).

Additionally, Appellant discloses (Specification Page 10), "In one embodiment, the set of video images is displayed within or in proximity to one or more game elements, such as within one or more symbol areas. In another embodiment, all or a portion of the set of video images is displayed partially or completely outside the one or more symbol areas or other game elements. In still another embodiment, the size of the various images in the set of video images can appear to change as the set is displayed. For example, a first image can be displayed within one symbol area, and subsequent, related images can grow in relative size to be displayed" (Page 10).

Loose discloses the claimed invention to include both static and dynamic images (Col. 2 Lines 30-35) that move (Fig. 9b), flash (Fig. 6), and morph (Fig. 10b) as superimposed images as well as dynamically change in size (Figs. 9a and 9b).

It would have been an obvious matter of design choice to dynamically alter the size of the supplemental graphical element, since Appellant has not disclosed that providing altered sizes solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the dynamically altering sizes of Loose.

In Reference to Claims 10-11, 20-21, 27-28, 35-36, 41-42, and 50-51

Loose as modified by Kay discloses an apparatus wherein the one or more processors causes the set of video images to be displayed by causing the set of video images to be displayed in a manner that the set of video images appears as an opaque or semi transparent overlay over each of the one or more of the multiple game element images that are overlaid (Col. 5 Lines 23-30).

In Reference to Claims 12, 22, 29, 37, 43, and 52

Loose as modified by Kay discloses an apparatus wherein the one or more processors further: determines whether a video image is associated with an alteration of a game element image within a game element area; and if the video image is associated with the alteration, causes an altered image to be displayed in the game element area (See “transform", “morphing”, and :moving” Col. 4 Lines 58-67 and Col. 5 Lines 1-10).

In Reference to Claim 23

Loose as modified by Kay discloses an apparatus further comprising a money/credit input/output (I/O) device for enabling a player to obtain credits; and player input devices that enable the player to specify a bet and to initiate a spin of the multiple reels (Col. 3 Lines 26-41).

In Reference to Claims 30-31

Loose as modified by Kay discloses a method wherein the electronic game is a game designed for execution on a wagering game machine, and causing the set of video images to be displayed comprises causing the set of video images to be displayed on a display device coupled to the wagering game machine (Col. 1 Lines 40-54).

In Reference to Claims 53-58

Loose as modified by Kay teaches of a computer-readable medium and processing (Fig. 11) which displays supplemental graphical elements to include displaying first and second supplemental graphical elements wherein the boundary changes from the first image to the second image of the set of images stored in the game data and within the set of images displayed on the underlying image (e.g., image 18), the boundary changing in accordance with the changes to the component (i.e., cherries image). Specifically, Figs. 9a and 9b show the cherries visual indicator 29 wherein a first image is shown in Fig. 9a and a second image shown in Fig. 9b wherein the boundary about each image changes, in these cases, increases, in accordance with the image's increased number and size of cherries).

Claim Rejections - 35 USC §103

h. Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loose in view of U.S. Patent No. 6,375,570 to Poole (Poole) of record.

Loose discloses a system substantially equivalent to Appellant's claimed invention. However, Loose does not teach the apparatus on a portable video game system, a personal computer, and a video game system using a television set.

Poole teaches of a display overlay over certain symbols resulting from a triggering condition on a portable video game system, a personal computer, and of a video game system using a television set (Col. 4 Lines 35-42) with full motion video (Col. 2 Lines 15-30) in order to create greater player entertainment and excitement.

It would have been obvious to one of ordinary skill in the art at the time of invention to employ the portable video game system, personal computer, and video game system using a television set (Col. 4 Lines 35-42) with full motion video as taught by Poole into the invention of Loose in order to create greater player entertainment and excitement by catering to the diverse gaming platforms preferred by players.

(10) Response to Argument

a. Appellant's arguments filed 8/2/2010 have been considered but are not persuasive with the exception of Appellant's arguments under 35 U.S.C. § 112, first paragraph and double patenting.

b. Appellant argues (see Appellant Arguments/Remarks pages 18-19) that Examiner has failed to address how Loose discloses pre-recorded video of a person, place, of thing, as claimed. Examiner respectfully disagrees and has provided a detailed mapping of the limitations to Loose wherein:

i. Giving the claim its broadest reasonable interpretation in light of the Specification, Examiner finds that the supplemental graphic element comprising pre-recorded video information is pre-recorded video comprising a film or movie frame or clip, graphical element, or rendered image, of a person, place, or thing. Examiner also finds that full motion video of a person, place, or thing, to be animated, or dynamically displayed, video images which give the appearance of full motion video.

ii. Loose discloses supplemental graphic elements of a "video indicator" 29 (Figs. 9a and 9b) comprising pre-recorded video information ("The system memory is used to store game-related data associated with the chance games played on the slot machine. The game-related data may, for example, include …audio resources, and video resources." (Col. 5 Lines 63-67) including full motion video of a person, place, or thing" (Figs. 9a and 9b, the video indicators 29 crossing the video screen "may be static or dynamic, and may include such graphics as payout values, a pay table, … special effects, thematic scenery, and instructional information" (Col. 2 Lines 30-34);

c. Appellant argues (see Appellant Arguments/Remarks page 19) that Claim 56 reciting boundary changes has been ignored. Examiner respectfully disagrees. Examiner has provided that the images of Figs. 9a and 9b disclose cherries which change in number and size from 4 to 6 and the boundary surrounding the cherries is dynamically altered to circumscribe the image which has just dynamically altered and also continue to allow the underlying image 18 to be seen.

d. Appellant argues (see Appellant Arguments/Remarks page 22) that Kay's

lenticular image display is not full motion video as recited in the claims. Examiner respectfully disagrees. Appellant's arguments are misdirected in that it is the teaching of Kay of using frames of film and video clips to represent full motion video not that Kay uses lenticular images to give an impression of the full motion video. Further, Appellant argues that Kay's images are not created using pixels. Examiner respectfully disagrees. Appellant's argument is misplaced for Examiner relies on Loose for the disclosure of using pixel data to generate the images. Again, Kay is relied upon for the enhancement that film and video clips can be incorporated into the game data of Loose. Lastly, Examiner notes Appellant's piecemeal analysis of Loose in view of Kay as Appellant argues the references individually. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Appellant has not presented an argument as to why one of ordinary skill in the art would not combine the references. Clearly, Kay, like Loose, integrates superimposing images onto a gaming machine to make the game more engaging for the player. Kay goes further to also include film and video clips such that it would have been obvious to in addition to the motivation provided as part of the rejection of the claims to also want to integrate more forms of content and media to appeal to a broader demographic frequenting the gaming establishment.

e Examiner notes that Appellant does not present any arguments as to the teachings of Loose in view of Poole for the teachings of Poole relied upon by Examiner.

f For the above reasons, the rejection of the claims in maintained.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Paul A. D'Agostino/
Examiner, Art Unit 3716

Conferees:

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